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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,513	09/27/2001	Gerhard Grolig		1227

7590 03/04/2004
Connolly Bove Lodge & Hutz LLP
1990 M Street NW
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Washington, DC 20006

EXAMINER

BECKER, DREW E

ART UNIT PAPER NUMBER

1761

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,513

Applicant(s)GROLIG ET AL. **Examiner**

Drew E Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 10-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al [Pat. No. 4,428,402] in view of Stall et al [Pat. No. 4,818,551].

Kubo et al teach a food casing comprising an inner hollow cavity, two ends, one end being tied off and turned into the cavity, an outer surface, the turned-in part extending approximately the entire length (Figure 1, #1-2), a closure placed on the tied end (Figure 1, #3), casing materials such as regenerated cellulose, starch, casein, polymers, synthetic materials, and nylon (column 4, lines 7-16), a lack of soaking, and placing the casing on a filling device to insert and edible filling (column 1, lines 41-50). Kubo et al do not teach an outer coating or impregnation, and liquid smoke. Stall et al teach a food casing impregnated with liquid smoke (column 1, lines 9-14). It would have been obvious to one of ordinary skill in the art to incorporate the liquid smoke of Stall et al into the invention of Kubo et al since both are directed to food casings, since Kubo et al already included various casing materials (column 4, lines 7-16), since liquid smoke was commonly applied to food casings, and since Stall et al teach that it provided uniform

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color, a smooth outer surface, coherency, a comparable pack ratio (column 3, lines 35-43).

3. Claims 5-6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al, in view of Stall et al, as applied above, and further in view of EP 0340776A1.

Kubo et al and Stall et al teach the above mentioned components. Kubo et al and Stall et al do not teach a cross-linking agent such as caramel, or a material that reduced water solubility. EP 0340776A1 teaches a food casing comprising caramel and shellac (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the caramel and shellac of EP 0340776A1 into the invention of Kubo et al, in view of Stall et al, since all are directed to food casings, since Kubo et al already included various casing materials (column 4, lines 7-16), since Stall et al already included coloring materials (column 1, line 13), and since the caramel and shellac of EP 0340776A1 provided coloring which was moisture insensitive (page 3, line 7-15).

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al, in view of Stall et al, as applied above, and further in view of JP 51079748A.

Kubo et al and Stall et al teach the above mentioned components. Kubo et al and Stall et al do not teach polyvinyl pyrrolidone. JP 51079748A teaches a food casing comprising polyvinyl pyrrolidone (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the polyvinyl pyrrolidone of JP 51079748A into the invention of Kubo et al, in view of Stall et al, since all are directed to food casings, since Kubo et al already included various casing materials including synthetic polymers

(column 4, lines 7-16), and since JP 51079748A teaches that a laminate including polyvinyl pyrrolidone had improved smoking properties and strength (abstract).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al, in view of Stall et al, as applied above, and further in view of Nausedas [Pat. No. 4,551,370].

Kubo et al and Stall et al teach the above mentioned components. Kubo et al and Stall et al do not teach fill ring. Nausedas teaches a food casing comprising a fill ring (Figure 14, #63). It would have been obvious to one of ordinary skill in the art to incorporate the fill ring of Nausedas into the invention of Kubo et al, in view of Stall et al, since all are directed to food casings, since Kubo et al already included turning an end into the cavity (Figure 1, #1-2), and since the ring of Nausedas also acted as a closure means for when the casing was stuffed.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al, in view of Stall et al, as applied above, and further in view of Crevasse [Pat. No. 5,215,495].

Kubo et al and Stall et al teach the above mentioned components. Kubo et al and Stall et al do not teach an outer packaging. Crevasse teaches a food casing in an outer packaging (Figure 5, #44). It would have been obvious to one of ordinary skill in the art to incorporate the packaging of Crevasse into the invention of Kubo et al, in view of Stall et al, since all are directed to food casings, since Kubo et al already included a casing which was meant to be shipped (column 1, line 39), and since the packaging of

Crevasse protected the casing during transport and prevented de-shirring prior to stuffing (column 2, lines 54-60).

Response to Arguments

7. Applicant's arguments filed December 29, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., turning the casing inside out) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the fill ring expanding the casing to the desired diameter when draw over the filling apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

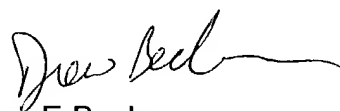
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Thur. 8am-5pm and every other Fri. 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Drew E Becker
Primary Examiner
Art Unit 1761

